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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,359	12/01/2003	Kouki Ozaki	OZAKI9	8081

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EXAMINER	
HALPERN, MARK	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,359	OZAKI ET AL.	
	Examiner	Art Unit	
	Mark Halpern	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *1,2,7,9,11,14,16,18,20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-6,8,10,12,13,15,17,19,21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1) Petition to withdraw the holding of abandonment was granted on 3/24/2006 and issued under a separate cover.

2) Acknowledgement is made of Amendment received 3/8/2006, wherein claims 3, 5-6, 10, 12-13, are amended. Claims 1-2, 7, 9, 11, 14, 16, 18, 20, remain withdrawn. Claims 3-6, 8, 10, 12-13, 15, 17, 19, 21, are pending.

Specification

3) Cross-Reference to Related Applications is not recited on page 1 of the Specification. The application identifies related applications 2002-347937 and 2002-347938, filed in Japan on 11/29/2002.

4) The amendment filed 3/8/2006, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: amended page 5 recites "a kneeding step in which the material mixture is kneeded until becoming viscous and then massive due to viscosity, thereby being formed into a forming material,...". The concept of material mixture being kneeded until becoming viscous and then massive due to viscosity, is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5) Claims 3-6, 8, 10, 12, 13, 15, 17, 19, 21, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 3 recites " a kneeding step in which the material mixture is kneeded until becoming viscous and then massive due to viscosity, thereby being formed into a forming material,...".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6) Claims 3-6, 8, 10, 12, 13, 15, 17, 21, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is not clear as to the phrase " a kneeding step in which the material mixture is kneeded until becoming viscous and then massive due to viscosity, thereby being formed into a forming material,...".

Claim 3 is not clear as to the phrase " a forming step in which the massive forming material is formed into a number of grains of forming material;".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) Claims 3-4, 8, 15, are rejected under 35 U.S.C. 102(b) as being anticipated by Masanori Endo (JP-2-235320) (translated copy provided to the Applicants).

Claims 3-4: Endo discloses a method of making an electrode for electrical double layer capacitor. In the process, active carbon fibers which have polyacrilic nitrile as raw material are pulverized, and into active carbon powder which passed through a mesh, propylene glycol as liquid lubricant is added; they mixed in a mixing step by a spiral mixer. Next into this mixture is added PTPE water soluble dispersion, and kneaded, thus by the kneading step obtaining rubbery viscous mixture. This viscous mixture is rolled by a roll, and thus producing a 1mm thick sheet shaped preformed compact. The preformed compact is then rolled into a thinner sheet of 0.25 mm thickness (Pg. 16, lines 6-23).

Claim 8: the binder assistant range is disclosed.

Claim 15: thermal control of kneading is disclosed in Embodiment 2 on Pg. 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8) Claims 5-6, 10, 12-13, 17, 19, 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo.

Claims 5-6: it would have been obvious, to one skilled in the art at the time the invention was made, to delay the adding of the binder assistant in order to better control the formation of the massive forming material in the design of Endo.

Claims 10, 12-13: the amounts of binder assistant added are disclosed (Pgs. 17-21).

Claim 17: thermal control of kneading is disclosed in Embodiment 2 on Pg. 17.

Claims 19, 21: it would have been obvious that the mixing be performed in a closed container to provide quality control of the mixing process.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9) Claims 3-6, 8, 10, 12-13, 15, 17, 19, 21, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/724,360. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present invention and the copending application recite a method of making an electrode for electrical double layer capacitor, wherein an activated carbon fiber and binders and additives are mixed and kneaded to obtain a mixture which is rolled to obtain a sheet of a prescribed thickness. Any differences are obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

10) Claims 3-6, 8, 10, 12-13, 15, rejection under 35 U.S.C. 103(a) as being unpatentable over Masanori (JP-2-235320), is withdrawn.

11) Claims 17, 19, 21, review was omitted in inadvertence.

12) Applicants' arguments filed 3/8/2006 have been fully considered but they are not persuasive.

Applicants allege that the inventions representing two species that are not so different and it would not constitute a serious burden to examine the entire application as per MPEP 803.

Examiner has not found the argument persuasive because the applicants failed to provide an appropriate showing or evidence to rebut the showing of serious burden set forth in the restriction requirement as is required by MPEP 803 – merely arguing that the search of the entire application could be made without serious burden does not meet the requirements of MPEP 803. The requirement was deemed proper and made FINAL.

Applicants allege that the cited prior art, Endo, does not disclose a mixing step that is divided into two sub-steps as in claimed invention.

A two step mixing is disclosed.

Applicants allege that the present claims provisional rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/724,360, is not proper.

The rejection is proper. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present invention and the copending application recite a method of making an electrode for electrical double layer capacitor, wherein an activated carbon fiber and binders and additives are mixed and kneaded to obtain a mixture which is rolled to obtain a sheet of a prescribed thickness. Any differences are obvious.

Conclusion

13) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Halpern

Mark Halpern
Primary Examiner
Art Unit 1731